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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,248	01/29/2001	Osamu Iwasaki	35.C15064	6831
5514	7590	05/16/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			PHAM, THIERRY L	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	

2624

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/770,248

Applicant(s)

IWASAKI, OSAMU

Examiner

Thierry L Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 4-6 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-6 and 14-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

- This action is responsive to the following communication: an Amendment filed on 11/18/04.
- Claims 4-6, 15-17 are pending in application; Claims 15-17 are newly added.
- Responsive to Drawing's objection (fig. 2) has been received and acknowledged.
- Responsive to Title's objection (title of invention is not descriptive) has been received and acknowledged.

#### ***Claim Rejections - 35 USC § 101***

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 17 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed invention is a computer related invention. The Computer-Implemented Invention Guidelines issued by the U.S. Patent and Trademark Office describe the procedures for examining such inventions. The first step is to determine whether the invention as defined by the claims falls within one of the three following categories of unpatentable subject matter: (1) Functional descriptive material such as a data structure *per se* or a computer program *per se*, (2) Non-functional descriptive material such as music, literary works or pure data, embodied on a computer readable medium; or (3) A natural phenomenon such as energy or magnetism. The invention as defined by the claims is not a natural phenomenon or pure data, however, it is a computer program *per se*, which does not mount/store on any computer-readable medium; therefore, these claims are rejected for non-statutory basis.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 4, 14, 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For example, claim 4 recites “decryption means for decrypting the encrypted print image data extracted by said analyzing means using a key corresponding to the print ID”. The examiner is unclear what subject matter represents “a key”. Is “a key” another random number or a “common key” that corresponding to the print ID as cited earlier in claim 4 and in the originally filed specification. The examiner interprets “a key” as a “session identifier” taught by Wiegley.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 4-6, 14-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Wiegley (U.S. 6711677).

Regarding claim 4, Wiegley further discloses an image data recording device (printer, fig. 2), comprising:

- common key generating means (“session identifier” generating means for generating a session identifier corresponding to a print session request from the host computer, fig. 3-6, col. 3, lines 63-67 and col. 4, lines 1-20) for generating a common key based on a print ID transferred from an image data processing device;
- management means (session identifier table 40, fig. 8, col. 4, lines 1-20) for managing the common key generated by said common key generating means and the print ID transferred from said image data processing device;

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- common key issue means (session identifier issuing means, cols. 3-4) for transmitting the common key (transmitting session identifier to personal computer 12 via network 14, fig. 2) generated by said common key generating means to said image data processing device;
- common key obtaining means (session identifier obtaining means, cols. 3-4) for obtaining the common key corresponding to the print ID (obtaining session identifier previously generated corresponding to a print request from a table, col. 5, lines 4-15) from said management means when the print ID and print control data are transmitted from said image data processing device;
- analyzing means (comparison/analyzing means, fig. 5b, cols. 5-6) for extracting encrypted print image data by analyzing a command of the print control data using the common key obtained by said common key obtaining means;
- decryption means (decryption means, fig. 3-6, cols. 5-6) for decrypting the encrypted print image data (personal computer encrypts print data with session identifier and session key, col. 4, lines 48-67) extracted by said analyzing means using a key (using an session identifier generated earlier, col. 5, lines 4-24) corresponding to the print ID; and
- print means (printer, fig. 2, abstract and col. 2, lines 30-55) for recording the print image data decrypted by said decryption means on a recording medium.

Regarding claim 5, Wiegley further discloses the apparatus according to claim 4, wherein said common key generating means generates the common key without regularity independent (col. 2, lines 29-54) of a value of the print ID.

Regarding claim 6, Wiegley further discloses the apparatus according to claim 4, wherein said decryption means performs a decryption process using a conversion table (table, fig. 8, col. 4, lines 1-20) generated using said key corresponding to the print ID.

Regarding claims 14-16: Claims 14-16 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 4-6; therefore, claims 14-16 are rejected for the same rejection rationale/basis as described in claims 4-6 above.

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Regarding claim 17: Claim 17 recites limitations that are similar and in the same scope of invention as to those in claim 4 except computer readable memory for storing computer programs. All computers/printers have some type of computer readable medium (i.e. RAM 32, fig. 2) for storing computer programs; hence claim 17 would be rejected using the same rationale as in claim 4.

### ***Response to Arguments***

Applicant's arguments filed 11/18/04 have been fully considered but they are not persuasive.

- Regarding claims 4 & 14, the applicant argued cited prior art of record (US 6711677 to Wiegley) fails to teach and/or suggest the concept of generating a common key based on a print ID transferred from an image data processing device.

In response, the examiner disagrees with the applicant's assertion. Wiegley explicitly teaches a printer 10 for generating a "session identifier 38a" and storing such session identifiers in a table 40 as shown in fig. 8 in response to a "secure print session request" transmitted from a personal computer 12, fig. 2, col. 3, lines 60-67 to col. 4, lines 1-20. Inherently, each secured print session request has its own identification (ID), so it can be distinguished from others. For example, as shown in fig. 3, a personal computer initiates "a secure print session, step 102" to a printer, in response, a printer generates a "session identifier, step 104" corresponding to the print session requested from the host computer, see col. 3, lines 60-67 to col. 4, lines 1-20 for more details. The examiner recommends the applicant to consider the cited prior art reference as a whole rather than individual columns cited in an office action.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. 5633932 to Davis et al, teach a method/apparatus for encrypting/decrypting print data ID.
- U.S. 5574789 to Nakamura et al, teach a method/apparatus for encrypting/decrypting print data using an image forming apparatus.

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

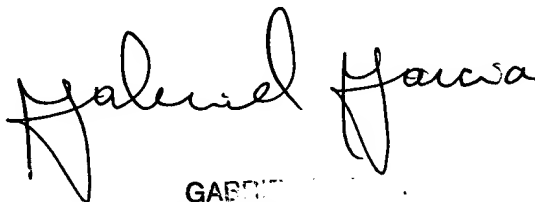
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (571) 2727439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



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